



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/272,562	03/19/99	ALAM	MDHS-378A

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IM22/1121

EXAMINER

GUARRIELLO, J

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/21/00

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

89/272562

Applicant(s)

Alam et al.

Examiner

John Guarniello

Group Art Unit

1791

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/31/2000, 8/7/2000
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11, 21-27 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11, 21-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). #5
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

15. The examiner acknowledges papers # 4 and 5, the amendment of 8/7/2000, and the IDS of 3/31/2000, which was not before the examiner when the action of 8/21/2000 was mailed.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. The examiner acknowledges the affirmation of Group I, claims 1-11. New claims 21-27 belong to Group I. Group II, claims 15-17 are the non-elected and have been cancelled. Restriction is made final for reasons of record.

18. The examiner responds to applicant's statement about prior art. The examiner refers applicant to 37 C.F.R. 1.56(a) and 37 C.F.R. 1.96, 1.97 and 1.98 regarding the duty to disclose statements about prior art.

19. The examiner refers applicant to page 6, line 25 in the specification regarding the use of the trademark "FM-300". Applicant has not responded to the objection that the trademark must be **accompanied by the generic**

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terminology. The examiner finds no **generic terminology** for the cited Trademark.

20. Claims 1, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Callahan 5,364,705.

Rejection is maintained. Applicant's arguments regarding the new limitations of "curable adhesive material being co-curable with the curable resin" have been considered but this is not a positive limitation but only requires the ability to so perform since it is similar to "capable of" language and implication. This new limitation does not constitute a limitation in a patentable sense, In re Hutchinson, 69 USPQ 138. Regarding the limitations of claims 10 and 11 with conductive ink and magnetic particles, '705 does describe "conductive ink layer" which generically encompasses the species of conductive ink and magnetic particles claimed. Claims lack novelty.

21. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. 4,321,404.

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Rejection is maintained. Applicant's arguments regarding curable adhesive material and being co-curable have been considered but this is not a positive limitation as discussed above in paragraph # 20 for the same reasons. Moreover, '404 does describe images, which are like ink patterns. Claim lacks novelty.

22. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al. 5,403,422.

Rejection is maintained. Applicant's arguments regarding curable adhesive material and being co-curable have been considered but this is not a positive limitation as discussed in paragraph # 20 for the same reasons. Moreover, Kawai describes a similar screen ink printed film carrier as stated in paragraph # 24 of the previous action of 8/2/2000, paper # 3.

23. Claims 3, 5-7, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. 5,403,422 in view of Pittman et al. 5,102,727.

Rejection is maintained. Applicant's arguments regarding curable adhesive material and being co-curable have been considered but this is not a

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positive limitation as discussed in paragraph # 20 for the same reasons.

Regarding claims 21-27, Kawai describes a thickness of the layer of at least 25 microns, (column 7, lines 1-5). Since Kawai describes the fibrous sublayer and the continuous layer, it would have been obvious to one of ordinary skill in the art to optimize the density values with the resolution after curing because where general conditions of the claimed invention are described this would be routine in this art, *In re Aller*, 105 USPQ 233. The claimed invention would still be obvious to one of ordinary skill in the art.

24. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. 5,403,422 in view of Ruffoni 5,185,381 and Whyzmuzis 5,714,526.

Rejection is maintained. Applicant's arguments regarding curable adhesive material and being co-curable have been considered but this is not a positive limitation as discussed in paragraph # 20 for the same reasons. The claimed invention would still be obvious to one of ordinary skill in the art.

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25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris , can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

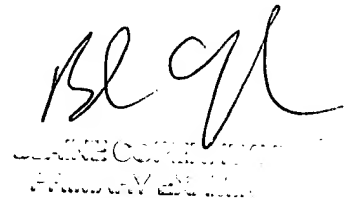
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John J. Guarriello:gj

Patent Examiner

November 9, 2000



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FEBRUARY 21 2001